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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,109

03/31/2006

Shinji Yoshida

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7590

10/14/2010

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EXAMINER

SCHLENTZ, NATHAN W

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

10/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/574,109	Applicant(s) YOSHIDA ET AL.	
	Examiner Nathan W. Schlientz	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,4-6 and 8-19.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/John Pak/
 Primary Examiner, Art Unit 1616

Continuation of 5. Applicant's reply has overcome the following rejection(s): rejection of claims 1, 4-6, 8, 17 and 18 under 35 U.S.C. 102(b) as being anticipated by Walker et al. (Materials and Structures, 1997).

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1 and 4-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Materials and Structures, 1997) in view of Okada (JP 07-291699), Nishimura et al. (JP 04-51506 U), Allen et al. (J. Economic Entomology, 1961; and J. Economic Entomology, 1964), and Moriwaki et al. (JP 60-230451) for the reasons of record in the previous Office action.

Applicant argues that Walker et al. fail to disclose or suggest incorporation of a termiticide into their compressed earth blocks. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has provided a *Okada*, *Nishimura et al.*, *Allen et al.* and *Moriwaki et al.* to provide a reason why one of ordinary skill in the art would add a termiticide to the concrete composition of Walker et al.

Applicant further argues that termites do not damage a concrete composition, and Walker's compressed earth block is not intended to control or prevent termite damage. The examiner respectfully argues that although termites do not damage concrete, it was well known at the time of the instant invention to add a termiticide to concrete in order to protect the structure supported by said concrete from damage by termites, as reasonably taught by *Okada*, *Nishimura et al.*, *Allen et al.* and *Moriwaki et al.* Therefore, one of ordinary skill in the art would be motivated to add a termiticide to the concrete composition of Walker et al. in order to protect a wooden structure supported by said concrete from damage by termites.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is clear from *Okada*, *Nishimura et al.*, *Allen et al.* and *Moriwaki et al.* that it was well known in the art at the time of the instant invention to add termiticides to concrete in order to protect from damage by termites. Therefore, one of ordinary skill in the art would have been motivated to add a termiticide to the concrete compositions of Walker et al.

Applicant also argues that one of ordinary skill in the art would not have had a reasonable expectation of success of arriving at the instantly claimed composition from the disclosure of Walker et al. because the reference fails to disclose or suggest a termiticide and a composition having termite-controlling properties. Applicant further argues that termite-controlling effects would not have been expected in view of the compressed earth block disclosed in Walker et al. because termites would travel along the surface of the composition. However, the examiner respectfully argues again that it would have been obvious to add a termiticide to the concrete composition of Walker et al. because it was well known at the time of the instant invention to add termiticides to concrete compositions, as reasonably taught by *Okada*, *Nishimura et al.*, *Allen et al.* and *Moriwaki et al.* With regard to the expectation of success, *Okada*, *Nishimura et al.*, *Allen et al.* and *Moriwaki et al.* provide the reasonable expectation of success. As noted by applicant, *Okada* teaches that incorporation of the termiticide in the concrete prevents passage of termites through cracks and on the surface of the concrete thus preventing damage to the pillars of the house; *Nishimura et al.* teach addition of a termiticide to concrete subflooring to prevent termite damage; *Allen et al.* teach incorporation of a termiticide in concrete wherein mortality of termites occurs through contact with the concrete; and *Moriwaki et al.* teach treating an underfloor ground with a termiticide followed by self-flowing concrete in order to prevent termite infestation and damage. Therefore, one of ordinary skill in the art would reasonably expect that addition of a termiticide to the concrete composition of Walker et al. would prevent infestation of termites and damage to the wooden structure supported by said concrete.